

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

<i>In re</i> Application of:)	
)	
John L. Lautzenhiser)	Confirmation No. 4024
)	
Serial No.: 09/801,201)	Examiner: Nam V. Nguyen
)	
Filed: March 7, 2001)	Group Art Unit: 2612
)	
For: RATE-OF-CHANGE SWITCHES)	Docket No.: 212-02
AND CONTROLLABLE)	
APPARATUS)	

REPLY BRIEF

This Reply Brief is submitted in response to Examiner's Answer filed April 13, 2011 ("Answer"), and further in support of Appellant's Appeal Brief filed January 4, 2011, and the Notice of Appeal filed on November 4, 2010, responding to the final Office Action mailed August 4, 2010.

I. REAL PARTY IN INTEREST

At the time Appellant filed this Appeal, the real party in interest was Lautzenhiser Technologies, LLC, assignee of the above-referenced application as indicated by the assignments recorded at the following reel/frame locations: 011614/0186 and 019848/0567. However, Lautzenhiser Technologies, LLC has since assigned its full ownership interest to Intelpro LLC as indicated by the assignment recorded on March 7, 2011, at reel/frame location 025912/0842.

II. ARGUMENT

The rejections against all of the pending claims under consideration in the above-captioned patent application should be reversed and overruled for at least the following reasons, and for all the reasons previously set forth in Appellant's Appeal Brief.

A. Examiner Relies On Impermissible Hindsight

Appellant respectfully submits that the combination of *Allen et al.* and *Levy* is improper regarding claims 1-5, 9-16, 31-35, 50-52, 62-63, 74 and 81-96 because the outstanding Office

Action impermissibly relies on hindsight based on information gleaned solely from Appellant's specification. As Examiner recognizes, the test for combining references is what the combination of disclosures **taken as a whole** would suggest to one of ordinary skill in the art. *In re McLaughlin*, 443 F.2d 1392, 170 U.S.P.Q. 209 (C.C.P.A. 1971). However, Examiner ignores the teachings of the "combination of disclosures **taken as a whole**" and instead uses impermissible hindsight bias to pick and choose allegedly relevant portions of the references, while dismissing the remainder of the references, to arrive at Appellant's claimed invention. Examiner seemingly ignores Appellant's prior arguments concerning MPEP § 2142 which states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of *the facts gleaned from the prior art.*" (Emphasis added). Given the lack of a suggestion or motivation contained in the prior art or the knowledge of one skilled in the art for the proposed combination, and based on Examiner's previous comments, it appears that the only suggestion or motivation to combine *Allen et al.* and *Levy* comes from Appellant's own disclosure. Thus, Examiner's approach violates MPEP § 2142 and *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), as discussed previously. In response to Appellant's prior arguments, Examiner alleges at page 16 of his Answer:

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize the need for a processor to determine the rate of increase in tilt angle of the lateral and longitudinal level using the lateral level sensor taught by *Levy* in the method for monitoring activity and providing feedback to a user concerning activity level performance of *Allen et al.* because determining the rate of increase in tilt angle would provide accurate feedback on their current level of activity based at least in part on the determined rate-of-change of the lateral level sensor by varying the rate of an audible tone output to reflect an actual and current activity level in the activity monitoring device.

Examiner, after observing Appellant's disclosure, merely takes a portion of *Levy* (the determination of a rate-of-change) and incorporates it into the activity monitor of *Allen et al.* to arrive at Appellant's invention. No teaching or suggestion in either *Allen et al.* or *Levy* implies combining the references as proposed by the Office Action. And Examiner states no rational basis for his conclusion that the inclusion of the tilt sensor of *Levy* would be obvious to one of ordinary skill in the art to "improve" the performance of the unrelated activity monitoring device of *Allen et al.* Moreover, Appellant's invention is not an improved activity monitoring device and *Allen et al.* does not relate to a "user manipulating [a] transducer" for purposefully controlling a device. Examiner's attempt to drastically alter the *Allen et al.* device contravenes

the guidance set forth in *Graham v. John Deere Co.* to “guard against slipping into use of hindsight . . . and to resist the temptation to read into the prior art the teachings of the invention in issue.” 383 U.S. 1 (1966). Accordingly, Appellant’s own disclosure is the only motivation for modifying *Allen et al.* with *Levy* as asserted.

Appellant respectfully submits that the Office Action relied on impermissible hindsight to combine *Allen et al.* with *Levy* and therefore Appellant’s invention is not obvious over the improper combination. For at least this reason, Appellant respectfully requests that the Board overrule the outstanding § 103(a) rejection regarding claims 1-5, 9-16, 31-35, 50-52, 62-63, 74 and 81-96.

B. *Levy* Is Non-Analogous Art

Appellant respectfully objects to the application of *Levy* against claims 1-5, 9-16, 31-35, 50-52, 62-63, 74 and 81-96 as *Levy* is non-analogous art. After Appellant’s Appeal Brief was filed and after Examiner submitted his Answer, the Court of Appeals for the Federal Circuit issued an opinion dealing directly with whether art is analogous. *In re Klein*, ___ F.3d ___, ___ U.S.P.Q. 2d ___, 2011 WL 2178134 at *2 (Fed. Cir., Jun. 6, 2011). To be used as a prior art reference in forming an obviousness determination under § 103(a), the reference must be analogous to the claimed invention. *Id.* As Appellant previously submitted and as the court in *Klein* reaffirmed: “Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, 381 F.3d 1320, 1325, 72 U.S.P.Q. 2d 1209, 1211-12 (Fed. Cir. 2004); *see also*, *In re Clay*, 966 F.2d 656, 658, 23 U.S.P.Q. 2d 1058 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979). As the court recognized, “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.” *Klein*, 2011 WL 2178134 at *3 (citing *Clay*, 966 F.2d at 659). “If a reference disclosure has the **same purpose** as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection.” *Id.* (Emphasis added).

In *Klein*, each of the cited references was pertinent to **some aspect** of the stated problem with which the inventor was involved, but each reference failed the analogous art test of *Bigio*, *Clay*, and *Wood*, because none of the references was related to the problem **as a whole**. For instance, three of the references (Roberts, O'Connor and Kirkman) "are each directed to a container designed to separate its contents, as opposed to one designed to facilitate the mixing of those contents [as in the Klein invention]." *Klein*, 2011 WL 2178134 at *4. Two other references (Greenspan and De Santo) "do not address multiple ratios or have a 'movable divider' [as claimed by Klein]." *Id.* at *5. In determining that none of the five references qualified as prior art, the court emphasized that the **purpose** of the references differed from the problem with which Klein was involved. *Id.* Regarding the Greenspan and De Santo references, the court held that while each is "directed to containers that facilitate the mixing of two separate substances together, an inventor considering the [present problem] would not have been motivated to consider either of those references since neither of the references shows a movable divider or the ability to prepare different ratios [as claimed by Klein]." *Id.* Similarly, regarding the Roberts, O'Connor and Kirkman references, the court found that "[a]n inventor considering the [present] problem . . . would not have been motivated to consider any of these references when making his invention, particularly since none of these references shows a partitioned container that is adapted to receive water or contain it long enough to be able to prepare different ratios in the different compartments." *Id.* at *4. As noted by the court, "If [a reference] is directed to a **different purpose**, the inventor would accordingly have had **less motivation or occasion** to consider it." *Klein*, 2011 WL 2178134 at *3 (quoting *Clay*, 966 F.2d at 659) (emphasis added).

In the present case, Applicant respectfully submits that, in accordance with *In re Klein* and related case law, the *Levy* reference constitutes non-analogous art which cannot be used to reject Appellant's pending claims as obvious under § 103(a). The Office Action summarily, but incorrectly, states that *Levy* is "in the same field of endeavor for controlling apparatus." As discussed previously regarding the first prong of the non-analogous art test, the *Levy* reference is not within the field of Lautzenhiser's endeavor because *Levy* does not relate to a "user manipulating [a] transducer" such as for controlling power wheel chairs or computing devices, or any other devices for that matter. Rather, *Levy* relates to preventing, through no user manipulation whatsoever, a tipper truck (*i.e.*, a dump truck) from overturning upon detecting an

extreme tilt angle of the bin of the tipper truck. The *Levy* reference does not provide for user manipulation or control of any device. For at least this reason, *Levy* is not within the field of Lautzenhiser's endeavor.

Regarding the second prong of the non-analogous art test, discussed in *Klein*, the system of *Levy* is not reasonably pertinent to the particular problem with which Lautzenhiser was involved because the purpose of the *Levy* reference differs significantly from Appellant's claimed invention. In particular, the purpose of *Levy* is to prevent, through no user manipulation whatsoever, a tipper truck (*i.e.*, a dump truck) from overturning. More specifically, *Levy* provides: "[a] system for preventing the overturning of the bin of a tipper truck during the raising of the bin for purposes of unloading includes a lateral level sensor to sense the lateral orientation of the tipper truck, and a longitudinal level sensor for sensing the longitudinal inclination of the bin." Abstract. It is unreasonable to conclude that the tipper truck system of *Levy* would logically commend itself to Lautzenhiser's attention in considering his problem of "providing for the needs of handicapped persons" to operate devices through active manipulation of a transducer when the purpose of *Levy* is quite clearly a safety function devoid of human interaction in "preventing the overturning of the bin of a tipper truck." As in *Klein*, the purpose of *Levy* differs so drastically from the particular problem with which Lautzenhiser was involved, it cannot logically be used in a § 103(a) determination because Lautzenhiser "would accordingly have had **less motivation or occasion** to consider [the *Levy* reference]." *Klein*, 2011 WL 2178134 at *3 (quoting *Clay*, 966 F.2d at 659) (emphasis added).

Because *Levy* is not within the field of Lautzenhiser's endeavor and because *Levy* is not reasonably pertinent to the particular problem with which Lautzenhiser was involved, *Levy* is non-analogous art and cannot be used to reject the pending claims 1-5, 9-16, 31-35, 50-52, 62-63, 74 and 81-96 under 35 U.S.C. § 103(a). Appellant respectfully requests that the rejection be withdrawn.

C. The Combination of *Allen et al.* and *Levy* Is Inoperable

Contrary to Examiner's unsupported conclusion that *Levy* tip-over prevention would improve the operation of the *Allen et al.* activity monitor, Appellant respectfully maintains that the combination and modification suggested in the Office Action would render the core functionality of the *Allen et al.* system inoperable. *Allen et al.* detects **activity** and is wholly

unconcerned with **tilt angle**. Examiner's Answer fails to set forth any support for his conclusion or even state a rationale as to how the *Allen et al.* device would be improved. Rather, the proposed combination would defeat the purpose of the *Allen et al.* device and transform it, and only with benefit of Appellant's disclosure, into something substantially different. Examiner has offered no new remarks regarding Appellant's prior argument, and as such Appellant incorporates fully its prior response relating to the inoperability of the proposed combination.

III. CONCLUSION

For at least the reasons discussed above, Appellant respectfully requests that the Examiner's final rejection of claims 1-5, 9-17, 19, 31-52, 62-63, and 74-96 be overruled by the Board.

Respectfully submitted,

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